

REMARKS

A. Status of Application

Claims 1-55 are pending. Claim 19 has been amended to correct a minor typographical error and claims 56-61 have been added. No new matter has been introduced. Claims 1-61 are presented for reconsideration.

B. Section 103 Rejections

Claims 1 through 55 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,706,441 to Lockwood in view of U.S. Patent No. 6,195,612 to Pack-Harris. Applicant respectfully traverses.

In the Response to Applicant's Arguments, the Office cites *In re Keller* and *In re Merck* stating that the references can not be attacked individually. Applicant notes that in order to establish a *prima facie* case of obviousness, three basic criteria must be met, including that the combined references must teach or suggest all the claim limitations. MPEP § 2143.4. Even if the alleged combination was made (Applicant notes that there is no motivation to combine references nor is there a showing that the resultant combination has a reasonable expectation of success), their combination fails to teach or suggest all the claim elements. The showing that the references individually lack disclosure of every element as recited in the claim indicates that their combination fails to teach or suggest all the claim elements.

1. *The Cited References Fail to Teach or Suggest Every Element Recited in Independent Claims 1, 10, 19, 23, 26, 27, 32, 48, and 52*

Independent claim 1 recites, in part: "wherein the quality rating tool is used to select one entity for providing health care services to a health care consumer." Independent claims 10, 19, 23, 26, 27, 32, 48, and 52 recite a similar element. Referring to page 4 of the Specification, a quality rating tool may be provided to allow health care consumers "to select a medical group most suitable for a consumer's need." This element, among others, is absent in each of the cited references.

The Lockwood reference is directed to a healthcare monitoring system. In particular, the Lockwood reference provides a system that can "determine multiple benchmarks for evaluating the cost-effectiveness of a given procedure delivered by health-care providers within the health-

care network, the multiple benchmarks corresponding to cases having different severity and complication levels.” (Column 4, lines 5-11). Referring to FIGs. 7, 8, 9, 10, and 10A of Lockwood, each of the steps provided is to assess the cost-efficiency of various providers including those who routinely handle more complicated cases and those who handle less complicated case (step 260). *See also* column 13, lines 33-41. The method shown in FIGs. 7, 8, 9, 10 and 10A fails to provide using the system to select an entity for providing health care services to a health care consumer as recited in independent claims 1, 10, 19, 23, 26, 27, 32, 48, and 52. It appears that Lockwood reference is silent to the use of cost-efficiency assessment by a health care consumer for the selection of any entity for providing health care services.

The Pack-Harris reference fails to provide the deficiencies. The Pack-Harris reference is directed to a management system to “analyze drug costs and utilization rates by individual physicians and by the entire medical group relative to a pharmacy benefit capitation for managing prescription drug activity.” (Column 2, lines 29-32). Nowhere in Pack-Harris is there disclosure of using the pharmacy management system to select an entity for providing health care services to a health care consumer as recited in independent claims 1, 10, 19, 23, 26, 27, 32, 48, and 52.

Thus, the cited references fail to disclose or even suggest all the elements of independent claims 1, 10, 19, 23, 26, 27, 32, 48, and 52. Claims 1, 10, 19, 23, 26, 27, 32, 48, and 52, and their respective dependent claims are patentably distinct over the cited references. Applicant respectfully requests the present obviousness rejection be withdrawn.

2. *The Cited References Fail to Teach or Suggest Every Element Recited in Independent Claims 28, 29, 30, 31, 51, 53, 54, and 55*

Independent claim 28 recites, in part: “calculating a score for a measure from the plurality of measures using data from the plurality of sources, wherein the measures include a safe dosing of a medication measure.” Independent claims 29, 30, 31, 51, 53, 54, and 55 recite a similar limitation. Referring to page 6 of the Specification, an example of clinical measurements is disclosed. In this non-limiting example, safe dosing of pain killers may be used to indicate “the frequency with which physicians with a medical group abide by safe prescribing practices to reduce the number of preventable illnesses.” The cited references fail to disclose or suggest such a concept, much less as it is correctly claimed in a more general embodiment.

Specifically, the Lockwood reference is silent to calculating a score for a measure, the measure including a safe dosing of medication measure. It appears that the only data that Lockwood uses pertains to claims record information (e.g., procedures, visit date, in-patient or out-patient status, type of sickness from the primary health-care database 10 and/or payment type, data-of-service, diagnosis codes from secondary health-care database 20) as shown in FIGs. 2 and 3.

The Pack-Harris reference fails to provide the deficiencies. As noted above, the Pack-Harris reference is related to a system for monitoring pharmacy drugs used and their actual cost. The Pack-Harris reference fails to teach or suggest calculating any scores of a measure, as recited in claims 28, 29, 30, 31, 51, 53, 54, and 55,

For at least these reasons, the cited references, individually, or in combination, fail to disclose all the recited elements. A *prima facie* case of obviousness has not been established. Independent claims 28, 29, 30, 31, 51, 53, 54, and 55, and their respective dependent claims are patentable over the cited references.

3. *There is No Motivation to Combine or Modify the Cited References*

To establish a *prima facie* case of obviousness, some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art must be present, to modify or combine the reference. See MPEP § 2142; *see also In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). With respect to the motivation to combine the references, the MPEP states “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01.

Nowhere in Lockwood is there a suggestion or motivation to combine or modify the health-care assessment tool of Lockwood with the pharmacy data from the Pack-Harris reference. The Lockwood disclosure is directed to insure the cost-efficiency between health-care providers with various skill set. See column 11, lines 32-38; *see also* the objectives disclosed in column 4, lines 1-32. Lockwood does not express a need or desire for the addition of pharmacy data, and in particular, the cost of the drugs as disclosed in the Pack-Harris reference for the cost-efficiency analysis.

It is also noted the Office's burden to establish a reasonable expectation of success. M.P.E.P. § 2143.02. None have been established here. The Office has provided no discussion as to why there would be a reasonable expectation of success in its proposed modifications of Lockwood's health-care assessment tool to include the technique of determining the cost of drugs described in Puck-Harris.

For at least these reasons as well, no *prima facie* case of obviousness can be established. Applicant respectfully requests the withdrawal of the present obviousness rejection.

C. *New Claims 56 through 61*

The present paper adds claims 56 through 61 which are directed to a method for selecting a health care provider by a health-care consumer. Support for the claims may be found, for example, in FIGs. 1 and 2 and supporting text of the Specification, and in the claims as filed.

As noted above, the cited references fail to disclose selecting at least one health care provider from the listing based on the provided score by the health-care consumer. For at least these reasons, claims 56 through 61 are patentably distinct over the Lockwood and Puck-Harris disclosures.

PETITION FOR EXTENSION OF TIME

Pursuant to 37 C.F.R. § 1.136(a), Applicant petitions for an extension of time of two-months up to and including April 3, 2007, in which to respond to the outstanding Action. A check for the large entity fee for a two-month extension of time (\$450.00) is enclosed. Should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included, the Commissioner is authorized to deduct or credit said fees to or from Fulbright & Jaworski Deposit Account No. 50-1212/UHGK:159/MCB.

CONCLUSION

Applicant believes that these remarks fully respond to all outstanding matters for this application. Applicant respectfully requests that the rejections of all claims be withdrawn so the claims may swiftly pass to issuance.

Should the Examiner desire to sustain any of the rejections discussed in this Response, the courtesy of a telephone conference between the Examiner, the Examiner's supervisor, and the undersigned attorney at 512-536-3005 is respectfully requested in advance.

Respectfully submitted,

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